09/291,147   7
CA9 19980011US1

REMARKS

Claims 1-16 and 21-35 are all the claims presently pending in the application.

Entry of this Amendment is proper under 37 CFR §1.116, since no new claims or issues are raised, the Examiner must respond on the record in order to justify how the rejection currently of record can be reasonably considered as meeting the initial burden of a proper rejection, to clarify issues remaining for Appeal, and to clarify whether any claims are still considered non-enabled, given the specification locations identified below.

It is noted that, notwithstanding any claim amendments made herein, Applicants' intent is to encompass equivalents of all claim elements, even if amended herein or later during prosecution.

Claims 27-35 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to be enabled.

Claims 1-16, 21-24, 28, 32, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wodarz et al. (U.S. Patent No. 5,999,912) in view of Agranat et al. (U.S. Patent No. 5,973,696).

Claims 25-27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wodarz in view of Agranat and further in view of Anderson et al. (U.S. Patent No. 6,021,202). Claims 29-31, 34, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wodarz/Agranat, and further in view of US Patent 6,061,697 to Nakao.

These rejections are respectfully traversed in the discussion below.

I. THE CLAIMED INVENTION

Applicants' invention, as defined for example in the non-limiting embodiment of independent claim 1 (and substantially similarly in independent claims 8 and 13) is directed to a programmable text processing module which loads the document and a parsing editor for initially parsing the document and thereafter incrementally parsing changes committed in the document.

As providing an editing function that, in one exemplary embodiment does not modify the document in any manner (although this functionality is not precluded in variations of the present

09/291,147   8
CA9 19980011US1

invention), the present invention provides "virtual" marks and associated action that typically exist only during the editing session (although, variations allow the metadata to be saved for subsequent/offline handling).

Therefore, in its role as an editor, the present invention includes also a mark control module that sets a plurality of marks in the document and provides a method for modifying the marks and clearing the marks. Each of the marks comprise selected information in the document and there is a means to link the selected information with a command, wherein the linking and setting is responsive to the operation of the parsing editor without user intervention.

As previously pointed out, the newly added dependent claims further define features of the present invention, such as, in a non-limiting embodiment (e.g., claims 27, 32, and 33), the marks inserted into the document are only present during a document processing.

An additional feature of the present invention, in a non-limiting embodiment (e.g., as defined by claim 28), is that the mark control module sets the plurality of marks solely as defined by the parsing editor.

Also a feature of the present invention, in a non-limiting embodiment (e.g., as defined by claims 29 and 34) is that the document is parsed by a pluralilty of parsing editors, each of the plurality of parsing editors providing a unique functionality.

Another feature of the present invention, in a non-limiting embodiment (e.g., as defined by claim 30), is that each of said plurality of parsing editors binds different actions to the same activemark set in the document.

A feature of the present invention, in a non-limiting embodiment (e.g., as defined by claims 31 and 35), is that a mark control module includes one capable of setting the marks in association with any of a plurality of parsing editors and a plurality of markup languages.

An exemplary configuration of an edit system incorporating the activemark structure of the present invention is shown in Fig. 1 of the application.

The conventional systems, such as those discussed below and in the Related Art section of the present application, do not have such a structure, and fail to provide for such an operation.

Indeed, such features are clearly not taught or suggested by the cited reference.

09/291,147   9
CA9 19980011US1

II. THE REJECTION UNDER 35 §112, FIRST PARAGRAPH

The Examiner alleges that claims 27-35 address subject matter that was not described in the specification as enabled.

Applicants submit the following support in the specification for these claims.

Relative to claim 27, Applicants point to page 2 at lines 15-18 and lines 21-22, page 3 at lines 9-11, page 5 at lines 8-11, page 7 at lines 14-21, and page 16 at line 21 through page 17 at line 1.

Relative to claim 28, Applicants point to page 2 at lines 16-18 and page 7 at lines 16-18.

Relative to claim 29, Applicants point to page 7 at line 25, page 16 at line 24, and page 36 at lines 16-21.

Relative to claim 30, Applicants point to page 11 at line 10-14 and page 23 at line 24.

Relative to claim 31, 34, and 35, Applicants point to page 2 at lines 3-5, page 3 at line 6, page 5 at line 4, and page 7 at line 27.

Relative to claim 32, Applicants point to page 2 at line 1-2.

Relative to claim 33, Applicants point to page 1 at lines 13 and 14 and page 2 at lines 8-10.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection for enablement.

III. THE PRIOR ART REJECTIONS

The Examiner alleges that Wodarz, when modified by Agranat, renders obvious claims 1-16, 21-24, 28, 32, and 33, and, when further modified by Anderson, renders obvious claims 25-27. The Examiner also alleges that Wodarz, when modified by Agranat and Nakao, renders obvious claims 29-31, 34, and 35.

However, it is brought to the Examiner's attention that the rejection currently of record fails to meet the initial burden of a *prima facie* rejection. More specifically, although the Examiner is allowed to give the broadest reasonable interpretation, such interpretation cannot ignore the plain meaning of the language of the claims or to provide an interpretation that is inconsistent with an interpretation that one of ordinary skill in the art would accept (e.g., see

09/291,147   10
CA9 19980011US1

MPEP § 2111: "The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach", and MPEP § 2111.01: "Plain Meaning refers to the meaning given to the term by those of ordinary skill in the art").

Applicants submit that the Examiner's interpretation of the independent claims does not meet this interpretation requirement and requests that the Examiner clarify the interpretation currently of record, in order to clarify issues for Appeal.

More specifically, the Examiner relies upon Wodarz as the primary reference. Applicants submit that one of ordinary skill in the art would not agree with the Examiner that this reference teaches all the claim elements in the independent claims as alleged by the Examiner, in accordance with the plain meaning of the language of the independent claims.

First, Applicants submit that one of ordinary skill in the art would not agree that Wodarz describes an editor, as this term would be understood by one of ordinary skill in the art. It is clear that Wodarz parses the document and then processes the document for ads, which ads the Examiner considers as equivalent to "marks".

This concept is entirely different from the role of an "editor", which term one of ordinary skill in the art would understand as being, for example: "A computer program that enables the user to create, view, and modify text files" (Dictionary of Computer and Internet Terms, 6th Ed., Downing et al., Barron's Educational Series, Inc., 1998, ISBN 0-7641-0094-7.

In contrast, in Wodarz, the HTML documents are clearly provided as an input into the device. The user does not use the device as an "editor", as that term is understood in the art. That is, Applicants submit that the Examiner's interpretation of Wodarz as providing an editing function would be inconsistent with the definition of one of ordinary skill in the art.

Second, even if Wodarz can be described as "initially parsing the document", Applicants submit that, because it is not an editor, one of ordinary skill in the art would not agree that this reference teaches, suggests, or has reason to: "... thereafter incrementally parsing changes committed in said document."

Third, the rejection currently of record fails to point to a "mark control module". The ads in Wodarz have been preset outside Wodarz (e.g., the ad tags are integral to the HTML document). Therefore, although the Examiner may be allowed to define "ad tags" as being

09/291,147   11
CA9 19980011US1

"marks" for purpose of the evaluation, Wodarz is not involved in the process of "... setting a plurality of marks in the document". Applicants additionally submit that, again because Wodarz is not an editor, one of ordinary skill in the art would not agree that, since Wodarz has no editing function, this reference has any capability of: "... modifying said marks", or "clearing said marks".

The Examiner relies upon lines 35-61 of column 3 and lines 6-11 of column 4 of Wodarz. However, Applicants submit that one of ordinary skill in the art would not agree with the Examiner's interpretation that these lines describe anything except a device that parses an HTML document to locate ad tags and then search out a database to find the ad that fits the tag criteria, and that this description is not an "editor" that can "set", "modify", or "clear" these ad tags.

Applicants submit that, until the Examiner points out specifically (e.g., by column and line) how Wodarz would be reasonably interpreted by one of ordinary skill in the art as teaching or suggesting the above limitations, the rejection of record fails to meet the initial burden. Applicants submit that one of ordinary skill in the art would not agree with the Examiner that the "broad brush" description at lines 35-61 of column 3 and lines 6-11 of column 4 of Wodarz describes an editing function as described in the independent claims.

The Examiner relies upon Agranat for demonstrating a graphical user interface, upon Anderson as demonstrating a method of "... inserting marks without user intervention", and upon Nakao for demonstrating "... a plurality of editors ...." Regardless of the propriety of modifying Wodarz in accordance with these secondary references, none of these references overcome the above-identified deficiency of Wodarz.

It is also pointed out that it would be improper to modify Wodarz to incorporate an editing feature, since such modification would change the principle of operation of Wodarz and would thereby be improper under MPEP §2143.01: "The proposed modification cannot change the principle of operation of a reference." That is, clearly, one of ordinary skill in the art would recognize that any editing of the HTML document to edit the ad tags is done outside of the device described in Wodarz and that any editing or modification to the ads is also clearly done outside of Wodarz.

Finally, relative to the motivations to modify Wodarz, it is noted that the Examiner merely recites the benefit to be gained if the modification were to be made. There is no suggestion in any

09/291,147   12
CA9 19980011US1

of these references to modify Wodarz to convert it into an editor, let alone any of the other missing elements.

That is, Applicants submit that the rationale of the rejection currently of record is merely circular reasoning (i.e., a conclusory statement of the result), as follows:

"The motivation to modify reference A to incorporate missing element B (found in reference C) is because one would thereby obtain the benefit of having incorporated missing element B".

Using the approach of the current rejection, everything would be rendered obvious, since any modification would become obvious, given that the motivation of the modification would be to provide the benefit of having made the modification.

Along these lines, it is pointed out that MPEP §2141.02 states: "*In determining the differences between the prior art and the claims, the question under 35 U.S.C.103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious*" (emphasis in MPEP itself).

This guideline reflects the well established concept in patentability evaluation that a new invention may "merely" be a new and different combination of known elements.

MPEP §2143.01 states a second guideline: "*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination*" (emphasis in MPEP itself).

Along these lines, Judge Rader wrote in the recent Federal Circuit Court of Appeals holding in *Ruiz v. A.B. Chance Co.*, Federal Cir., No. 03-1333, January 29, 2004:

> "*In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.*" (Emphasis by

09/291,147   13
CA9 19980011US1

Applicants)

Thus, turning to the clear language of the claims as defined by independent claim 1 (and substantially similarly by independent claims 8 and 13), there is no teaching or suggestion of *"[a] processing system for processing a document, said processing system comprising:*

a programmable text processing module having means for loading the document and a parsing editor for initially parsing the document and thereafter incrementally parsing changes committed in said document;

a mark control module having means for setting a plurality of marks in the document, means for modifying said marks, and means for clearing said marks, and each of said marks comprising selected information in the document and means for linking said selected information with a command, said linking means and said means for setting being responsive to the operation of said parsing editor without user intervention;

a graphical user interface module having means for displaying the document and means for controlling the display of the document; and

an edit control module having means for controlling said text processing module, means for controlling said mark control module, and means for controlling said graphical user interface module" (emphasis Applicant's).

The method of Wodarz, even if combined (arguendo) with that of Agranat (and their attendant disclosure), neither teaches the specific structures of the loading means, setting means, modifying means, clearing means, linking means, displaying means, and controlling means of the invention, nor is such a method a reasonable structural equivalent of the claimed loading means, setting means, modifying means, clearing means, linking means, displaying means, and controlling means.

Thus, for the reasons stated above, independent claim 1 (and substantialy similarly independent claims 8 and 13) are patentable over Wodarz and Agranat

Additionally, dependent claims 2-7, 9-12, 14-16, 21-24, and 27-35, when combined with independent claims 1, 8, and 13 respectively, define additional novel and non-obvious features.

Regarding the rejection of claims 25-27 under 35 U.S.C. § 103(a) as being unpatentable

09/291,147   14
CA9 19980011US1

over Wodarz and Agranat in view of Anderson, and the rejection of 29-31, 34, and 35 under 35

U.S.C. § 103(a) as being unpatentable over Wodarz and Agranat in view of Nakao, these claims

when combined with independent claim 1, are also patentable. That is, none of Wodarz, Agranat,

Anderson, and Nakao, alone or (arguendo) in combination, teach or suggest the present invention

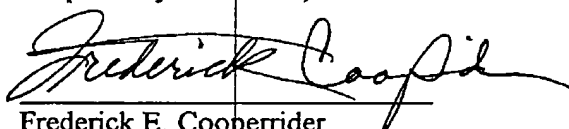defined by the claims.

IV. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-16 and 21-35, all the claims

presently pending in the application, are patentably distinct over the prior art of record and are in

condition for allowance.   The Examiner is respectfully requested to pass the above application to

issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the

Examiner is requested to contact the undersigned at the local telephone number listed below to

discuss any other changes deemed necessary in a <u>telephonic or personal interview</u>.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any

overpayment in fees to Assignee's Deposit Account No. 50-0510.
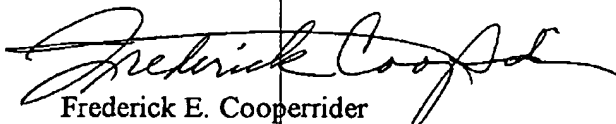
Respectfully Submitted,

Date: _3/29/04_

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<u>CERTIFICATION OF TRANSMISSION</u>

I certify that I transmitted via facsimile to (703) 872-9306 this Amendment under 37 CFR §1.116
to Examiner Almari Romero Yuan on March 29, 2004.

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